

03-23-01

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PATENT

Attorney Docket No. ELITRA.011A

Date: March 21, 2001

Page 1

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jc-986 U.S. PTO  
09/815242  
03/21/01

ASSISTANT COMMISSIONER FOR PATENTS

WASHINGTON, D.C. 20231

ATTENTION: BOX PATENT APPLICATION

Sir:

Transmitted herewith for filing is the patent application of

Inventor(s): Robert Haselbeck, Kari L. Ohlsen, Judith W. Zyskind, Daniel Wall, John D. Trawick,  
Grant J. Carr, Robert T. Yamamoto, and H. Howard Xu

For: IDENTIFICATION OF ESSENTIAL GENES IN PROKARYOTES

Enclosed are:

- (X) 4 sheets of drawing.
- (X) Sequence Listing in computer readable format on CD-ROM (2 copies).
- (X) Sequence Submission Statement.
- (X) Return prepaid postcard.
- (X) Conditional Petition Under 37 C.F.R. § 1.183 to suspend 37 C.F.R. § 1.52(b)
- (X) Certificate of Mailing by Express Mail
- (X) CD ROM Submission Statement Transmittal Letter (2 copies)

The present application qualifies for small entity status under 37 C.F.R. § 1.27. The fees are calculated below:

CLAIMS AS FILED				
FOR	NUMBER FILED	NUMBER EXTRA	RATE	FEE
Basic Fee			\$355	\$ 355
Total Claims	44 - 20 =	24 ×	\$9	\$ 216
Independent Claims	44 - 3 =	41 ×	\$40	\$1,640
If application contains any multiple dependent claims(s), then add			\$135	\$
FILING FEE TO BE PAID AT A LATER DATE		\$2,211		

**PATENT**

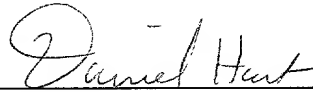
Attorney Docket No. ELITRA.011A

Date: March 21, 2001

Page 2

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(X) Please use Customer No. 20,995 for the correspondence address.



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Daniel Hart

Registration No. 40,637

Attorney of Record

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Daniel Hart, Ph.D.

Assistant Commissioner for Patents  
Washington, D.C. 20231

**CERTIFICATE OF MAILING BY "EXPRESS MAIL"**

**Attorney Docket No.** : ELITRA.011A

**Applicant(s)** : Haselbeck, et al.

**For** : IDENTIFICATION OF ESSENTIAL GENES IN  
PROKARYOTES

**Attorney** : Daniel Hart

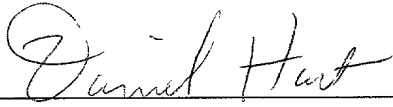
**"Express Mail"**  
**Mailing Label No.** : EL 739677750 US

**Date of Deposit** : March 21, 2001

I hereby certify that the accompanying

Transmittal; Specification in 573 pages; 4 sheets of drawings; Sequence Listing  
Submission Statement; 2 copies of Sequence Listing in computer readable format on CD-  
ROM; Conditional Petition to Suspend; CD-ROM Submission Statement Transmittal  
Letter (2 copies), Prepaid Postcard

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee"  
service under 37 CFR 1.10 on the date indicated above and are addressed to the Assistant Commissioner  
for Patents, Washington, D.C. 20231.

  
Daniel Hart

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Haselbeck, et al.  
Appl. No. : Unknown  
Filed : Herewith  
For : **IDENTIFICATION OF  
ESSENTIAL GENES  
IN PROKARYOTES**

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SEQUENCE SUBMISSION STATEMENT

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

Two (2) copies of the Sequence Listing in computer readable form as required by 37 C.F.R. § 1.821(e) are submitted herewith.

The contents of the CD-ROM labeled "Copy 1" is identical to the contents of the CD-ROM labeled "Copy 2." A copy of this transmittal letter is attached to the CD-ROM labeled "Copy 2."

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 21, 2001

By: Daniel Hart

Daniel Hart  
Registration No. 40,637  
Attorney of Record  
620 Newport Center Drive  
Sixteenth Floor  
Newport Beach, CA 92660  
(619) 235-8550

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Haselbeck, et al.	)	Examiner:	Not Yet
		)		Assigned
Appl. No.:	Not Yet Assigned	)		
		)	Group Art Unit:	Not Yet
Filed:	Herewith	)		Assigned
		)		
For:	IDENTIFICATION OF ESSENTIAL	)		
	GENES IN PROKARYOTES	)		

**CD-ROM SUBMISSION STATEMENT**  
**TRANSMITTAL LETTER**

Assistant Commissioner for Patents  
 Washington, D.C. 20231

Dear Sir:

Two (2) compact discs in compliance with 37 C.F.R. § 1.52(e) is submitted herewith.

As required by 37 C.F.R. § 1.52(e)(3), the compact disc is in IBM-PC format, compatible with MS-Windows operating system, and contains the following file:

File Name: SEQLIST\_FINAL\_9PM

Size in Bytes: 37,487,912

Date Created: March 20, 2001

The contents of the compact disc labeled "Copy 1" is identical to the contents of the compact disc labeled "Copy 2." A copy of this transmittal letter is attached to the compact disc labeled "Copy 2."

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated:

March 21, 2001

By:

Daniel Hart

Daniel Hart

Registration No. 40,637

Attorney of Record

620 Newport Center Drive

Sixteenth Floor

Newport Beach, CA 92660

(619) 235-8550

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Haselbeck, et al.	)	Examiner:	Not Yet
		)		Assigned
Appl. No.:	Not Yet Assigned	)		
		)	Group Art Unit:	Not Yet
Filed:	Herewith	)		Assigned
		)		
For:	IDENTIFICATION OF ESSENTIAL	)		
	GENES IN PROKARYOTES	)		
		)		

**CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183**  
**TO SUSPEND 37 C.F.R. § 1.52(b)**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

Applicants hereby respectfully petition the Commissioner, in the event Applicants' submission of two copies of a compact disc in accordance with 37 C.F.R. § 1.52(e) is not in full compliance with said rule, to suspend the Rule set forth in 37 C.F.R. § 1.52(b) and accept the provided electronic version of the sequence listing.

**FACTS**

Applicants have herewith submitted the above-captioned application for filing with the United States Patent and Trademark Office ("the PTO" or "the Office"). In a good faith effort at full compliance with 37 C.F.R. § 1.52(e), promulgated by the PTO on September 8, 2000 as part of Changes to Implement the Patent Business Goals, and having the effective date of November 7, 2000, Applicants have submitted a compact disc (CD-ROM) in duplicate, along with the necessary transmittal letters setting forth the necessary information. The CD-ROM contains a sequence listing.

Specifically, Applicants' CD-ROM submission complies with § 1.52(e)(1)(ii), stating that "a sequence listing" may be "submitted to the Office on a compact disc." In addition, each CD-ROM complies with the read-only requirements of § 1.52(e)(2), and the electronic standards of § 1.52(e)(3)(i), as well as with the labeling requirements of § 1.52(e)(6). The discs are transmitted in a proper padded envelope and are accompanied by a transmittal letter in compliance with § 1.52(e)(3)(ii). The CD-ROM is submitted in duplicate and each copy is correctly labeled as "Copy 1" or "Copy 2," as required by § 1.52(e)(4). The specification contains an incorporation-by-reference paragraph, which properly incorporates the information on the CD-ROMs into the body of the specification, in compliance with § 1.52(e)(5).

#### PETITION

If the Commissioner finds that the CD-ROM submission of Applicants is not in compliance with § 1.52(e), or that § 1.52(e) is inapplicable to the present submission, Applicants respectfully petition the Commissioner as to the following:

Applicants petition the Commissioner under 37 C.F.R. § 1.183 to suspend 37 C.F.R. § 1.52(b)(1), as effective November 7, 2000, or alternatively, the previous version of 37 C.F.R. § 1.52(b). § 1.52(b)(1) requires that "the application . . . must (i) Comply with the requirements of paragraph (a) of this section," which sets forth the paper requirement of all submissions to the Office. The previous version of 37 C.F.R. § 1.52(b) sets forth the paper requirement of all submissions to the Office.

Applicants respectfully submit that the submission of an application having over 13,000 pages of sequence information is an extraordinary situation. Such submission in paper form creates a great deal of burden on both the Applicants, for submitting, and the Office, for processing, a voluminous document of such magnitude. Applicants respectfully submit further that justice requires that the Commissioner waive requirements of § 1.52(b)(1), and accept the Applicants' submission of the CD-ROM information, due to the good faith efforts of Applicants to comply with a new and untested rule, 37 C.F.R. § 1.52(e). Furthermore, Applicants

respectfully submit that paper submission of any part of an application is not a statutory mandate, and as such, is subject to waiver by the Commissioner.

**CONCLUSION**

Applicants respectfully maintain that the CD-ROM submission of the sequence listing is in full compliance with all the Rules and that Applicants have made every effort in good faith to comply with all the Rules. In the event that Applicants' submission is inadvertently not in compliance, Applicants respectfully petition the Commissioner to suspend the Rules and accept the Applicants' electronic submission in view of the sheer size of the submitted document.

In the event the Commissioner finds it necessary to consider this petition, please charge Deposit Account No. 11-1410 for any petition fee required by 37 C.F.R. § 1.183 and set forth in 37 C.F.R. § 1.17(h).

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated:

March 21, 2001

By:

Daniel Hart

Daniel Hart

Registration No. 40,637

Attorney of Record

620 Newport Center Drive

Sixteenth Floor

Newport Beach, CA 92660

(619) 235-8550



ELITRA.011A



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Haselbeck, et al.

App1. No. : 09/815,242

Filed : March 21, 2001

For : IDENTIFICATION OF  
ESSENTIAL GENES IN  
PROKARYOTES

Examiner : Unknown

) Group Art Unit:

) Unassigned

) I hereby certify that this correspondence is  
) being faxed and sent via Federal Express to  
) Annette Masiello on October 19, 2001 for  
) hand delivery to the Assistant  
) Commissioner for Patents, Washington,  
) D.C. 20231, on

October 19, 2001

(Date)

*Daniel Hart*

Daniel Hart, Reg. No. 40,637

**POWER TO INSPECT AND MAKE COPIES UNDER**  
**37 C.F.R. § 1.14(d) AND M.P.E.P. § 104**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 C.F.R. § 1.14(d) and M.P.E.P. § 104, please permit Annette Masiello or her representative, Rayline Petitt, to inspect the above-entitled application, and to make copies of any of the papers she may desire.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Oct. 19, 2001

By: *Daniel Hart*

Daniel Hart

Registration No. 40,637

Attorney of Record

620 Newport Center Drive

Sixteenth Floor

Newport Beach, CA 92660

(619) 235-8550



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

) Group Art Unit Unknown

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[illegible]

Appl. No. : 09/815,242  
Filed : March 21, 2001

Accordingly, we respectfully request your assistance in moving the application to publication. Please feel free to contact the undersigned to advise us how we can expedite the publication of the application.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated:

Oct. 19, 2001

By:

Daniel Hart

Daniel Hart  
Registration No. 40,637  
Attorney of Record  
620 Newport Center Drive  
Sixteenth Floor  
Newport Beach, CA 92660  
(619) 235-8550

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